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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/068,695
Filing Date: February 05, 2002
Appellant(s): JEANE, GEORGE C.

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GROUP 3600

William W. Stagg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 18 June 2004 appealing from the Office action mailed 22 September 2003.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that Group I: claims 1, 3, 4, 21 and 22 do not stand or fall together; Group II: claims 5-7, 11, 13-17, 23 and 24 do not stand or fall together; Group III: claims 8-10, 18, 19, 25 and 26 do not stand or fall together but fails to argue each claim separately as set forth in 37 CFR 1.192(c)(7) and (c)(8). The following groups stand or fall together as argued by the Appellant:

Group I: Claims 1, 2, 4 and 21

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Group II: Claim 22

Group III: Claims 5, 13, 23

Group IV: Claims 6, 11, 14, 16, 24

Group V: Claims 8, 18, 25

Group VI: Claims 9, 19, 26

(8) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Evidence Relied Upon

1,869,441	Shakespeare	8-1932
3,784,124	Shumate et al.	1-1974
6,070,822	Zwayer et al.	6-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by

Shumate et al. (3,784,124).

Shumate shows a fishing comprising:

a frame 19 having a forward and rearward ends and two sides as seen in Figures 1 and 2;

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a transversely oriented, revolvable cylindrical spool 23 mounted to the frame 19 and a recessed channel 25 for holding a length of fishing line;

a line guide 22 mounted on the frame in a fixed position forward of the spool; and

means 29 for controlling the rotation of the spool and dispensing fishing line from the

channel 25 as the spool 23 rotates during casting of the a fishing lure and onto the channel of the spool during retrieval of the fishing line.

In regards to claim 3, Shumate shows the channel 25 is substantially rectangular cross-section.

In regards to claim 4, Shumate shows the vertical midpoint of the line guide 22 is positioned so as to be no lower than approximately the vertical mid-point of the of the recessed channel and no higher that approximately the top rim of the recessed channel, as seen in Figure 2.

In regards to claim 21, Shumate shows a fishing comprising:

a frame 19 and a means for mounting the frame on a longitudinally extending fishing rod, as seen in Figures 1 and 2;

a revolving cylindrical spool 23 mounted to the frame 19 and positioned so that the spool's axis of rotation is transverse to the longitudinally extending fishing rod and a recessed channel 25 of substantially rectangular cross-section, being narrow in depth and centered in the transverse axis;

a ring-shaped line guide 22 mounted on the frame in a fixed position forward of the spool; and

means for releasing the spool and dispensing fishing line from the channel 25 as the spool 23 rotates during casting of the a fishing lure; and

means 29 for coiling line onto the channel of the spool during retrieval of the fishing line.

In regards to claim 22, Shumate shows the vertical midpoint of the line guide 22 is positioned so as to be no lower than approximately the vertical mid-point of the of the recessed channel and no higher that approximately the top rim of the recessed channel, as seen in Figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, 11, 13-17, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shumate et al. (US 3,784,124) in view of Zwayer et al. (US 6,070,822).

In regards to claims 5, 13, and 23, Shumate fails to show the ring guide member 22 as being substantially circular.

Zwayer teaches a ring guide member 128 being circular in shape and that is smooth to reduce friction and snaps into place, as explained in column 6 lines 66-67, and column 7, on lines 1-2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ring guide of Shumate to include a circular shape as suggested by Zwayer, to reduce friction and minimize backlash.

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With respect to claims 6, 11, 14, 16 and 24, Shumate as modified by Zwyer does not disclose specific values for diameter of the line guide and the width of the line channel. However, one of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill in the art to construct the diameter of the line guide in the range of about $\frac{3}{8}$ to about $\frac{5}{8}$ of the width of the channel (claims 6, 14 and 24), and more specifically, to make the line guide approximately $\frac{3}{16}$ inches in diameter and the line channel approximately $\frac{11}{32}$ inches in width (claims 11, 16).

Claims 8-10, 18, 19, 25 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shumate in view of Shakespeare (US 1,869,441).

In regards to claims 8, 18, and 25 Shumate fails to show the ring guide member 22 as being substantially vertically extending elongate ring.

Shakespeare teaches a ring guide member 4 shaped as an elongated endless guide eye (col.1 line 47) having an improvement over the prior art wherein the line guide eye provides a rounded wear surface to the line (col. 1 line 3-4), and press fits to the frame (col. 2 line 57-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ring guide of Shumate to include a substantially vertically extending elongate ring shape as suggested by Shakespeare, to reduce friction and minimize backlash.

With respect to claims 9, 19 and 26, Shumate as modified by Shakespeare does not disclose specific values for diameter of the line guide and the width of the line channel.

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However, one of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill in the art to construct the diameter of the line guide in the range of about $3/8$ to about $5/8$ of the width of the channel, and more specifically, to make the line guide approximately $3/16$ inches in diameter and the line channel approximately $11/32$ inches in width.

(11) Response to Argument

In regards to the argument on page 8, paragraph 3, that the claims are directed to a bait-casting reel. The limitation of a bait-casting reel is only in the preamble of claim 21. The limitation in the preamble that the reel is a bait-casting reel does not imply any structure and there is not structure claim that is particular to a bait-casting reel. The reel of Shumate operates according to the Appellant's definition of a bait-casting reel. The reel revolves during the cast and the weight of the lure pulls line from the revolving spool. Shumate, col. 2, lines 29-30.

Claims 1, 2, 4 and 21

In regards to the argument on page 9, paragraph 1, that Shumate does not disclose a reel that revolves during the cast to dispense the line and that there is no separate "recessed channel." As stated above, the reel revolves during the cast and the weight of the lure pulls line from the revolving spool. Shumate, col. 2, lines 29-30. In regards to the recessed channel, Shumate discloses a recessed channel in the spool, as seen in Figure 2, the Appellant's spool just has thicker flange walls of the spool, a feature not claimed. The Appellant then argues the Shumate fails to suggest or disclose a spool configuration that is beneficial to control "backlash" as the

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spool revolves during casting. The Appellant fails to disclose such a feature. Page 5, 3rd full paragraph of the Appellant's specification filed 02/05/02, describes the location of the line guide relative to the channel that will act to minimize backlash, not the configuration of the spool channel.

In regards to comparison between the prior art of Shumate and the disclosed invention on page 9, paragraph 2, Shumate shows a rectangular configuration of the channel that allows the line to be distributed from the spool. The rectangular channel configuration of Shumate would inherently perform in the same way as the Appellant's claimed invention.

In regards to the argument on page 10, paragraph 1, that an improper 102 analysis has been made. All the claimed limitations have been treated. The argument that the subject matter of each claim as a whole must be taken into consideration is an element of a 103 analysis of obviousness, which is not applicable here.

In regards argument on page 10, paragraph 1, that the "means for controlling the rotation of the spool..." would prevent a rejection under 35 USC § 102(b). The Appellant has not pointed to any structural features that are different from Shumate that Appellant feels are encompassed by the means for controlling the spool. In regards to the argument the Shumate fails to the limitations of claim 21, no specific arguments to the limitation of claim 21 are made.

Claim 22

In regards to the argument at the top of page 11, Shumate shows the forward position of the line guide in Figures 1-4. The Appellant argues that the position of the line guide is coincidental. For a reference to anticipated a claimed invention, it does not have to solve the problem intended by the claimed invention. Again, the Appellant has not pointed to any

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structural features that are different from Shumate that Appellant feels are encompassed by the means for controlling the spool. The reel revolves during the cast and the weight of the lure pulls line from the revolving spool. Shumate, col. 2, lines 29-30.

Claims 5, 13, 23

In response to the Applicant's argument that there is no suggestion to combine the references on page 12, paragraph 2, the Examiner recognizes that the references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of the disclosure taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, Zwyer et al. is relied upon to teach a smooth circular opening for to protect the line from abrasion.

In response to appellant's arguments against the references individually on page 12, paragraph 3, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument on page 13, paragraph 1 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight

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reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Here, Zwayer teaches a line guide which snaps into an aperture and protects the fishing line from abrasion. Appellant further argues the Shumate and Zwayer are different types of reels, and therefore teach away from each other. A line guide is generic to any type of fishing reel make the two references combinable analogous art.

Claims 6, 11, 14, 16, 24

One of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been obvious through routine experimentation and optimization, for one of ordinary skill in the art to size the line guide with respect to the channel to take in consideration all the benefits of the optimum or workable ranges, including backlash.

Claims 8, 18, 25

In response to the Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that the references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of the disclosure taken as

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a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, Shakespeare is relied on to teach an improved line guide which presents a round wear surface to the line and also provides a finish for the reel. Shakespeare is not relied on to teach the rectangular channel which allows the fishing line to be distributed uniformly as the spool rotates.

In response to the Appellant's argument on page 16, paragraph 2, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. *In regards to claim Linter*, 458 F.3d 1013, 173 USPQ 560 (CCPA 1972). See MPEP 2144. Further, the Appellant does not disclose how the line is distributed uniformly?

Claims 9, 19, 26

One of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been obvious through routine experimentation and optimization, for one of ordinary skill in the art to size the line guide with respect to the channel to take in consideration all the benefits of the optimum or workable ranges, including backlash.

(12) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Evan H. Langdon



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